



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

52

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,850	05/29/2001	Robert Gary	10010459-1	8299

29053 7590 04/21/2005

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

TIV, BACKHEAN

ART UNIT	PAPER NUMBER
----------	--------------

2151

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,850

Applicant(s)

GARY, ROBERT

Examiner

Backhean Tiv

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-71 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

Claims 1-71 are pending in this application. Claims 68-71 are new claims. This is a response the amendment filed on 1/6/05.

NonStatutory provisional Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 19, 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of US Patent Application 09/816,693 in view of US Patent 6,664,978 issued to Kekic et al.(Kekic).

This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 1 of US Patent Application 09/816,693 teaches all the limitations of claims 1, 19, 31 except for:

said at least one gateway maintaining usage information detailing the amount of usage of said gateway in managing said one or more network elements; and usage management system communicatively coupled to said at least one gateway, wherein said at least one gateway is operable to communicate said usage information to said usage management system.

However, Kekic teaches said at least one gateway maintaining usage information detailing the amount of usage of said gateway in managing said one or more network elements(col.16, lines 31-47); and usage management system communicatively coupled to said at least one gateway, wherein said at least one gateway is operable to communicate said usage information to said usage management system(Abstract, col.2, line 30-col.3, line 10, col.15, line 55-col.16, line 30, col.22, line 1-67).

Therefore it would have been obvious to one ordinary skill in the art to modify the system of US Patent Application 09/816,693 to add said at least one gateway maintaining usage information detailing the amount of usage of said gateway in managing said one or more network elements; and usage management system communicatively coupled to said at least one gateway,

wherein said at least one gateway is operable to communicate said usage information to said usage management system as taught by Kekic in order to manage heterogeneous computer network elements(Kekic, col.1, lines 18-20).

One skilled in the art would have been motivated to combine US Patent Number 09/816,693 and Kekic in order to provide a method to manage heterogeneous computer network elements(Kekic, col.1, lines 18-20).

Claim 56 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of US Patent Application 09/816,693 in view of US Patent 6,775,267 issued to Kung et al.(Kung). This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 1 of US Patent Application 09/816,693 teaches all the limitations of claim 56 except for:
charged a fee that is based at least in part on the amount of usage of said at least one gateway and billing said customer based at least in part on the amount of usage of said at least one gateway.

However, Kung teaches charged a fee that is based at least in part on the amount of usage of said at least one gateway(Abstract) and billing said customer based at least in part on the amount of usage of said at least one gateway(Abstract).

Therefore it would have been obvious to one ordinary skill in the art to modify the system of US Patent Application 09/816,693 to add charged a fee that is based at least in part on the amount of usage of said at least one gateway and billing said customer based at least in part on the amount of usage of said at least one gateway as taught by Kung in order to bill a variable bit rate communication(Kung, col.2, lines 30-31).

One skilled in the art would have been motivated to combine US Patent Application 09/816,693 and Kung in order to provide a method to a multi-network access and least cost routing among broadband network(Kung, col.1, lines 9-15).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 68,69,71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 68,69,71 recites the limitation "the communicated ". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-55 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,664,978 issued to Kekic et al. (Kekic).

As per claim 1, a system for monitoring usage of gateways responsible for managing one or more network elements(col.2, lines 33-45), said system comprising: at least one gateway responsible for managing one or more network elements(Abstract, col.7, lines 10-55); said at least one gateway maintaining usage information detailing the amount of usage of said gateway in managing said one or more network elements(Fig.37 G); and usage management system communicatively coupled to said at least one gateway, wherein said at least one gateway is operable to communicate said usage information to said usage management system(Abstract, col.2, line 30-col.3, line 10, col.15, line 55-col.16, line 30, col.22, line 1-67).

As per claim 2, the system of claim 1 wherein said usage includes gateway processing(col.15, lines 55-67).

As per claim 3, the system of claim 2 wherein said gateway processing includes handling of messages received from said one or more network elements(col.1, line 63-col.2, line 5).

As per claim 4, the system of claim 3 wherein said at least one gateway includes a SNMP gateway responsible for managing one or more SNMP network elements, and wherein said handling of messages includes handling of SNMP messages(col.1, line 63-col.2, line 50).

As per claim 5, the system of claim 4 wherein said SNMP messages includes at least one message selected from the group of: SNMP Trap messages, SNMP Get Messages, and SNMP Set messages(col.50, lines 57-60).

As per claim 6, the system of claim 1 wherein said at least one gateway includes code executable to track said amount of usage of said at least one gateway(col.82, lines 16-25).

As per claim 7, the system of claim 6 wherein said code includes code implemented within an Application Program Interface(API)(col.82, lines 16-25).

As per claim 8, the system of claim 7 wherein said API includes functionality that can be invoked to maintain a count of one or more types of usage of said at least one gateway(Fig.1-10, col.82, lines 5-50).

As per claim 9, the system of claim 8 wherein said at least one gateway includes code that, upon said at least one gateway performing a type of usage, invokes said functionality of said API to increment a count for said type of usage (Fig.1-10, col.82, lines 5-50).

As per claim 10, the system of claim 9 wherein said code invokes said functionality by passing a descriptor of said type of usage to said API, and wherein said API maintains a count for said descriptor (Fig.1-10, col.82, lines 5-50)..

As per claim 11, the system of claim 1 wherein said at least one gateway includes code executable to track said amount of different types of usage of said at least one gateway(Fig.4-37,Abstract).

As per claim 12, the system of claim 11 wherein said code increments a count maintained for a particular one of said different types of usage upon said at least one gateway performing said particular one type of usage(Fig.4-37,Abstract).

As per claim 13, the system of claim 12 wherein said different types of usage includes handling of different types of messages from said one or more network elements (Fig.4-37,Abstract).

As per claim 14, the system of claim 1 wherein said usage management system is operable to poll said at least one gateway for said usage information(col.7, lines 19-30, col.46, lines 58-64).

As per claim 15, the system of claim 1 wherein said usage management system is operable to compile received usage information into a file(col.16, lines 15-67).

As per claim 16, the system of claim 15 wherein said usage management system is communicatively coupled to a plurality of gateways, and wherein said usage management system is operable to compile usage information received from said plurality of gateways into a file(col.16, lines 15-67).

As per claim 17, the system of claim 15 wherein said usage management system is operable to electronically communicate said file comprising usage information to a recipient(col.17, lines 1-40).

As per claim 18, the system of claim 1 wherein said usage management system is operable to electronically communicate said usage information received from said at least one gateway to a recipient(Fig.37).

Claims 19, 31, 45 are rejected based on the same rationale as claim 1 (see claim 1 above).

Claims 20,32,33,39,46,55 are rejected based on the same rationale as claim 2 (see claim 2 above).

Claims 21, 40, 47 are rejected based on the same rationale as claim 3 (see claim 3 above).

Claim 48 is rejected based on the same rationale as claim 4 (see claim 4 above).

Claim 49 is rejected based on the same rationale as claim 5 (see claim 5 above).

Claims 22,34,41,50 are rejected based on the same rationale as claim 6 (see claim 6 above).

Claims 23,35 are rejected based on the same rationale as claim 7 (see claim 7 above).

Claim 36 is rejected based on the same rationale as claim 8 (see claim 8 above).

Claims 24,37 are rejected based on the same rationale as claim 9 (see claim 9 above).

Claims 25,38 are rejected based on the same rationale as claim 10 (see claim 10 above).

Claims 26,51 are rejected based on the same rationale as claim 11 (see claim 11 above).

Claims 27,42,52 are rejected based on the same rationale as claim 12 (see claim 12 above).

Claims 28,43,53 are rejected based on the same rationale as claim 13 (see claim 13 above).

Claims 29,54 are rejected based on the same rationale as claim 14 (see claim 14 above).

Claim 44 is rejected based on the same rationale as claim 16 (see claim 16 above).

Claim 30 is rejected based on the same rationale as claim 17 (see claim 17 above).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 56-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,664,978 issued to Kekic et al. (Kekic) in view of US Patent 6,775,267 issued to Kung et al. (Kung).

As per claim 56, Kekic teaches a method for providing to a customer at least one gateway for use in . managing one or more network elements , said method comprising the steps of:

providing to said customer at least one gateway for use in managing one or more network elements(Abstract, col.7,lines 10-55);
said at least one gateway comprising functionality to track the amount of its usage(Fig.37G).

However, Kekic does not explicitly teach wherein said customer is charged a fee that is based at least in part on the amount of usage of said at least one gateway and billing said customer based at least in part on the amount of usage of said at least one gateway.

Kung teaches wherein said customer is charged a fee that is based at least in part on the amount of usage of said at least one gateway(Abstract) and billing said customer based at least in part on the amount of usage of said at least one gateway(Fig.7c, col.5, lines 44-63, col.4, lines 15-23).

Therefore it would have been obvious to one ordinary skill in the art to modify the method of Kekic to explicitly add wherein said customer is charged a fee that is based at least in part on the amount of usage of said at least one gateway and billing said customer based at least in part on the amount of usage of said at least one gateway as taught by Kung in order to bill a variable bit rate communication(Kung, col.2, lines 30-31).

One skilled in the art would have been motivated to combine Kekic and Kung in order to provide a method to a multi-network access and least cost routing among broadband network(Kung, col.1, lines 9-15).

As per claim 57, the method of claim 56 wherein said usage includes gateway processing(Kekic, col.15, lines 55-67).Motivation to combine set forth in claim 56.

As per claim 58, the method of claim 57 wherein said gateway processing includes handling of messages received from said one or more network elements(Kekic, col.1, line 63-col.2, line 5). Motivation to combine set forth in claim 56.

As per claim 59, the method of claim 56 wherein said functionality is provided by software code executable within said at least one gateway(Kekic, col.82, lines 16-25).

As per claim 60, the method of claim 56 wherein said at least one gateway further comprises: functionality to track an amount of different types of usage(Kekic, Fig.4-37, Abstract). Motivation to combine set forth in claim 56.

As per claim 61, the method of claim 60 wherein said at least one gateway increments a count maintained for a particular one of said different types of usage upon occurrence of said particular one type of usage at said at least one gateway(Kekic, Kekic, Fig.4-37, Abstract). Motivation to combine set forth in claim 56.

As per claim 62, the method of claim 60 wherein said different types of usage includes handling of different types of messages from said one or more network elements(Kekic, col.1, line 63-col.2,line 5). Motivation to combine set forth in claim 56.

As per claim 63, the method of claim 56 further comprising the step of: communicating said amount of usage from said at least one gateway to a usage management system to which said at least one gateway is communicatively coupled(Kekic, col.16, lines 15-67). Motivation to combine set forth in claim 56.

As per claim 64, the method of claim 63 wherein said communicating step is responsive to polling of said at least one gateway by said usage management system(Kekic, col.7, lines 19-30, col.46, lines 58-64). Motivation to combine set forth in claim 56.

As per claim 65, the method of claim 63 wherein said usage management system is communicatively coupled to a plurality of gateways, further comprising the step of: said usage management system compiling usage information received from said plurality of gateways(Kekic, col.16, lines 15-67). Motivation to combine set forth in claim 56.

As per claim 66, the method of claim 65 further comprising the step of: said usage management system electronically communicating compiled usage information to a recipient(Kekic, col.17, lines 1-40). Motivation to combine set forth in claim 56.

As per claim 67, the method of claim 63 further comprising: said usage management system electronically communicating said amount of usage received from said at least one gateway to a recipient(Kekic, Fig.37). Motivation to combine set forth in claim 56.

Claims 68-71 are rejected for the same reasons as claim 56.

Response to Arguments

The examiner withdraws all previous 112 second paragraph rejection due to applicant's amendment.

Applicant's arguments filed 1/6/05 have been fully considered but they are not persuasive.

Applicant's primary argument, as per claim 1-55, is that Kekic does not teach a gateway maintains usage information detailing the amount of usage of the gateway in managing network elements.

The examiner does not agree for the following reasons:

During patent examination, the pending claims must be "given >their< broadest reasonable interpretation consistent with the specification." > *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

In this case, the claim recites a gateway maintains usage information detailing the amount of usage of the gateway in managing network elements. In Fig.37G, Kekic teaches, in one example, polling a network element every 300 seconds. This polling would be a gateway maintaining usage information detailing the amount of usage of the gateway because a request is sent to the element every 300 seconds so every 300 seconds the gateway is being used.

As per claim 56-67 claims recites, "said at least one gateway comprising functionality to track the amount of its usage". The applicant argues that Kung does not

Art Unit: 2151

teach this limitation, however, Kung is not relied upon to teach this limitation. Kekic is relied upon to teach this limitation. See arguments for claim 1-55.

The applicant also argues, as per claim 56-67, that Kung does not teach customer is billed based on the amount of usage of the gateway. The examiner disagrees, Kung teaches, Fig.7c, col.5, lines 44-63, col.4, lines 15-23, a service provider(gateway) that charges users for providing communication between devices. A service provider provides the necessary means, bit rate transfer of data, in order for two devices to communicate.

The applicant has not overcome the Provisional Double Patenting rejection set forth in the previous Office Action. The applicant makes the same arguments as those addressed above (see arguments of claims 1-67), they are not persuasive. The applicant also states that US application 09/816,693 was amended on September 20,2004 and that the amended claims are different from when the claim was reviewed by the examiner. This fact is true, that the amended claims in application 09/816,693 are different, however, the amended claims of US application 09/816,693 still teaches limitations of this instant application with the secondary references of Kekic and Kung.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571)272-3941. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER

Application/Control Number: 09/867,850

Page 17

Art Unit: 2151

A handwritten signature in black ink, appearing to read 'BT', with a long horizontal stroke extending to the right.

Backhean Tiv

2151

4/6/05